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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,728	01/19/2000	Toshihiro Shima	Q57645	3501

7590 10/22/2003

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EXAMINER
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JONES, DAVID

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 10/22/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/487,728

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

David L Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on October 10, 2001 was filed after the mailing date of the application on January 19, 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
3. The information disclosure statement (IDS) submitted on February 25, 2003 was filed after the mailing date of the application on January 19, 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Fig. 2A, items 21C and 21N. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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5. Receipt is acknowledged of drawings submitted they were received on May 16, 2000.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Leiman U.S. Patent 6,469,796.

Regarding claim 1, Leiman discloses a printer (fig 5, #62), which is connected to a computer (fig 5, #116) via a network (fig 5, #58), comprising: transfer means (fig 5, #56) for exchanging information with said computer via said network; storage means (fig 5, #26) for storing a document file to be printed that is received from said computer via said transfer means (column 5, lines 1-10); configuration file generation means (fig 5, #128) for employing print setup information in said document file, which is received from said computer via said transfer means, to generate a configuration file concerning a print setup for said document file (column 5, lines 19-33); print setup reference means (fig 6; column 7, lines 17-25) for employing said configuration file to generate a menu indicating contents of said print setup, and for transmitting said menu via said transfer means to said computer; and printing means (fig 5, #62) for printing said document file that is stored in said storage means in accordance with said configuration file.

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Regarding claim 2, Leiman discloses a printer that further comprises a setup change means (column 7, lines 17-25), for, when said computer operates said menu via said transfer means, updating contents of said configuration file in accordance with the operation.

Regarding claim 3, Leiman discloses a printer, wherein said menu (fig 9) includes upper directories that are generated for individual entries in said print setup, and lower directories that are generated for individual setup values, one of which is included in each of said entries, and wherein said menu is formed by correlating visual display elements corresponding to said document file with said lower directories (column 7, lines 33-39).

Regarding claim 4, Leiman discloses a method for controlling a printer, which is connected to a computer via a network, comprising steps of: receiving (fig 5, #124; column 5, lines 1-10), from said computer via said network, a document file to be printed and print setup information for said document file; storing said document file (fig 5, #126); employing said print setup information to generate a configuration file concerning a print setup for said document file (column 5, lines 19-33); employing said configuration file to generate a menu (fig 6) that listing contents of said print setup, and transmitting said menu to said computer (column 7, lines 17-25); and printing said document file in accordance with said configuration file (fig 5, #62).

Regarding claim 5, Leiman discloses a computer-readable recording medium (fig 5, #52) on which a control program is stored for a printer that is connected to a computer via a network, said program permitting the computer of said printer to perform: a transfer function (fig 5, #56) for exchanging information with said computer via said network; a storage function (column 5, lines 1-10) for storing to a storage device, a document file to be printed that is received from said computer; a configuration file generation function (column 5, lines 19-33), for employing print

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setup information in said document file, which is received from said computer, to generate a configuration file concerning a print setup for said document file; a print setup reference function (column 7, lines 17-25), for employing said configuration file to generate a menu indicating contents of said print setup, and for transmitting said menu to said computer; and a printing function (column 6, lines 27-34) for printing said document file that is stored in said storage device in accordance with said configuration file.

Regarding claim 6, Leiman discloses a recording medium, wherein said program further comprises a setup change function (column 7, lines 17-25), for, when said computer operates said menu, updating the contents of said configuration file in accordance with the operation.

Regarding claim 7, Leiman discloses a recording medium, wherein said menu (fig 9) includes upper directories that are generated for individual entries in said print setup, and lower directories that are generated for individual setup values, one of which is included in each of said entries, and wherein said menu is formed by correlating visual display elements corresponding to said document file with said lower directories (column 7, lines 33-39).

Regarding claim 8, Leiman discloses a network printing system comprising: a host computer (fig 5, #116) for generating and transmitting print data; and a printer (fig 5, 62) that is connected via a network to said host computer, said host computer comprising: user interface means (column 5, lines 19-33) for providing information for a user and for accepting instructions from said user; print data generation means (column 5, lines 48-60) for converting, into print data, a file that is designated via said user interface means; and communication means (column 5, lines 48-60) for communicating with said printer; and said printer comprising: transfer means (fig 5, #56) for exchanging information with said host computer via said network; storage means

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(fig 5, #126) for storing said print data received from said host computer via said transfer means; configuration file generation means (column 5, lines 19-33) for employing print setup information for said print data, which are received from said host computer via said transfer means, to generate a configuration file concerning a print setup for said print data; print setup reference means (column 7, lines 17-25) for employing said configuration file to generate a menu listing the contents of said print setup, and for transmitting said menu via said transfer means to said user interface means; and print means (fig 5, #62) for printing, in accordance with said configuration file, said print data stored in said storage means.

Regarding claim 9, Leiman discloses a network printing system, wherein said printer further comprises setup change means (column 7, lines 17-25), for, when said computer operates said menu via said transfer means, updating the contents of said configuration file in accordance with the operation.

Regarding claim 10, Leiman discloses a network printing system, wherein, when said host computer moves said print data (column 8, lines 1-18) included in said menu to a different printer via said user interface means, the first printer to receive said print data transmits to said different printer said print data stored in said storage means.

Regarding claim 11, Leiman discloses a network printing system, wherein said menu (fig 9) includes upper directories that are generated for individual entries in said print setup, and lower directories that are generated for individual setup values, one of which is included in each of said entries, and wherein said menu is formed by correlating visual display elements corresponding to said document file with said lower directories (column 7, lines 33-39).

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Regarding claim 12, Leiman discloses a network printing system comprising: a computer having a file transfer protocol client (fig 5, #116) for transmitting a document file to be printed in accordance with a file transfer protocol; and a printer (fig 5, #62) being connected to said computer via a network and having a file transfer protocol file server (fig 5, #52), said file transfer protocol file server comprising: storage means ((fig 5, #126) for storing said document file that is received; configuration file generation means (fig 5, #128; column 5, lines 19-33) for employing print setup information in said document file and an initial value that is set in advance to generate a configuration file concerning a print setup for said document file; print setup reference means (fig 6) for employing said configuration file to generate a menu (column 7, lines 17-25) that lists the contents of said print setup, and for transmitting said menu to said computer; and setup change means (column 7, lines 17-25) for, when said menu is operated by said computer, updating the contents of said configuration file in accordance with an operation, wherein said document file stored in said storage means is printed in accordance with said configuration file.



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*Conclusion*


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barrett et al. U.S. Patent 5,323,393 discloses a method and apparatus for controlling the same functions of a networked printer that can be manually selected from the front panel of the printer, but remotely through an interactive network board connectable to the printer via a bi-directional printer interface and connectable to a local area network via a local area network interface. Patel et al. U.S. Patent 5,566,278 discloses an object-oriented printing system includes objects that provide query, data transfer, and control methods. Davidson, Jr. et al. U.S. Patent 5,699,493 discloses an improved printing system is provided having at least one host computer and a printer in which the printer acquires print job accounting information and communicates it to the host computer via NPAP messages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (6:30am - 3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

dlj

  
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